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**BEFORE THE BOARD OF PATENT
APPEALS AND INTERFERENCES**

**PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Customer No.: 23641

Application No.: 09/406,290

Confirmation

No.: 1448

Filing Date: September 24, 1999

Attorney

Docket No.: 37168/82045

First Named

Inventor: Jeffrey K. Dellinger

Group Art

Unit: 3627

Examiner

Name: Michael A. Cuff

Title:

Method and Apparatus For
Providing Retirement Income
Benefits

Certificate Under 37 CFR 1.8(a)

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REPLY BRIEF

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Sir:

This is a reply to the Examiner's Answer (hereinafter, the "Answer") mailed
March 18, 2004 (Paper No. 17).

Reply to Examiner's Answer

On page 2 of the Answer, the Examiner states that the Appeal Brief (hereinafter, the "Brief") filed by Appellant on December 22, 2003, "does not contain a statement identifying the related appeals and interferences which will directly effect or be directly affected by or have a bearing on the decision in the pending appeal" The undersigned respectfully disagrees. Such a statement is present on page 2 of the Brief under the heading "RELATED APPEALS AND INTERFERENCES."

On page 3 of the Answer, the Examiner states that "appellants statement in the brief that certain claims do not stand or fall together is moot because appellant, on page 11 of the brief, chooses not advance arguments of dependent claims being separately patentable." The Examiner goes on to state that all of claims 1-43 stand or fall with claims 1 and 4, in that only those claims are argued in the Brief. Appellant and Appellant's undersigned representative strongly disagree for the reasons set forth below.

As for the dependent claims, Appellant states on pages 4 and 5 of the Brief that dependent claims 9, 10, 16, 27 and 38 stand alone. On page 11 of the Brief, beginning in line 14, Appellant identifies the limitation of claim 9 believed to be undisclosed by the references relied upon by the Examiner, and asserts that such limitation would independently support patentability. Each of dependent claims 10, 16, 27 and 38 are similarly treated in lines 20-25 of page 11 and lines 1-16 of page 12.¹ In the Answer, the Examiner makes no arguments or counter-assertions regarding dependent claims 9, 10, 16, 27 and 38. In the Final Office Action dated February 28, 2003 (hereinafter, the "FOA") from which this appeal is taken, claims 9 and 10 are rejected summarily, without reference to either Golden or Corlett, or any other prior art. (See numbered section 4 of the Detailed Action, page 5, lines 17-19, in the FOA.) Claim 16 is

¹ Appellant notes that a typographical error appears in line 16 of page 12. That line presently reads "Claim 28 stands alone." The line should read "Claim 38 stands alone."

not mentioned at all in the FOA. Claim 27 is summarily rejected in the FOA without reference to any prior art. (See page 8, lines 9-10 of the Detailed Action of the FOA.) Claim 38 was similarly treated in the FOA. (See page 9, lines 20-21 and page 10, lines 1-4 of the FOA.)

To summarize, Claims 9, 10, 16, 27 and 38 were designated by Appellant as standing alone, by reference to specific limitations not disclosed by the art of record. These dependent claims were ignored by the Examiner in the Answer, and were either ignored or summarily rejected in the FOA without reference to or support in the prior art. Accordingly, Appellant respectfully requests that these rejections be reversed, and that these dependent claims be allowed.

As for the independent claims, Appellant states in the Brief that all independent claims stand alone. The independent claims are 1, 4, 7, 11, 12, 15, 17, 26 and 35. In the FOA, the Examiner grouped certain of these independent claims together. Namely, independent claims 7, 11, 12, and 15 were discussed as a group (along with their respective dependent claims) in numbered section 4 of the FOA. The other independent claims were treated individually (along with their respective dependent claims) in separate, numbered sections in the FOA.

On page 7 of the Brief, Appellant quotes a portion of the Examiner's rejections of claims 1-3. This quote discusses the difference between the primary reference (Golden) and the claimed method, and sets forth the combination with the secondary reference (Corlett) from which this appeal is taken. Appellant then notes, with reference to the FOA, that "identical language is found in the last three paragraphs of numbered sections 4, 5 and 6 (addressing claims 7-16, 17-25, and 26-34, respectively), and substantially identical language is found in the last three paragraphs of numbered section 7 (addressing claims 35-43)." On the remainder of page 7, all of page 8 and most of page 9 of the Brief, Appellant addresses the Examiner's quoted basis for the rejections, concluding with a request that the Examiner's rejections of all of claims 1-3,

and 7-43 be reversed. The undersigned representative of Appellant sees no reason why these arguments should have been repeated several times in the Brief to address rejections that are identically stated in the FOA. This is especially so since it is expressly stated in the Brief that the arguments set forth are responding to the identically-stated rejections of the several independent claims. Accordingly, Appellant respectfully submits that independent claims 1, 4, 7, 11, 12, 15, 17, 26 and 35 stand alone, and that the Examiner's rejections of each should be reversed for the reasons stated in the Brief.²

On page 4 of the Answer, the Examiner takes issue with Appellant's statement in the Brief that Appellant and the Examiner agreed that Golden relates to a fixed annuity plan. Neither Appellant nor the undersigned intended to mischaracterize the Examiner's prior positions in any way. The portion of the FOA relied upon in support of this statement in the Brief is numbered section 8 on page 11 of the Detailed Action of the FOA. This is the "Response to Arguments" that was added by Examiner Buchanan in the final rejection (the remaining text of the Detailed Action being a verbatim restatement of text from the previous Office Action).³ In that section, Examiner Buchanan reacts to Appellant's position that Golden relates only to fixed annuity plans by stating "[V]ariable annuities being the general form of annuities, with payments that vary on a host of circumstances, fixed annuities are merely a special case of variable annuities in which the variability of the payments is zero." Appellant takes this language as indicating that Examiner Buchanan agrees that the various embodiments disclosed by Golden do, in fact, relate to fixed annuities.

Appellant has made numerous arguments, and placed evidence by way of affidavit, in this record to counter both Examiners' assertions that the feature which distinguishes

² Independent Claim 4 was separately rejected in the FOA, and separately addressed in the Brief.

³ Applicant notes that Examiner Buchanan authored the previous Office Action and the FOA, while Examiner Cuff authored the Examiner's Answer.

a fixed annuity plan from a variable annuity plan is whether the payments made to the annuitant vary, or not. That is not what distinguishes a variable annuity from a fixed annuity. Payments made under a fixed annuity plan are dictated by the terms of the annuity contract, and cannot be adjusted from period to period after annuitization. This does not mean that the payments cannot vary. The contract can, for instance, provide for increases in the payments over the life of the plan in anticipation of inflation. However, the payments cannot be adjusted upwardly or downwardly from period to period after the contract is formed, as described in the claims on appeal. To do so, would violate the terms of the fixed annuity contract. In a fixed annuity, as in all the embodiments disclosed by Golden, the amounts of the future payments are fixed by contract at the time of annuitization.

In the Answer, the Examiner further states that the distinctions between variable and fixed annuities, and the arguments relating thereto, are not relevant and are moot “because a ‘variable annuity’ has not been positively recited in the methods claims.” Appellant submits that the claims are specific to a “variable annuity benefit plan,” with each of the claims clearly stating so in the preamble. While the Examiner may be discounting this recitation because it does occur in the preamble, Appellant respectfully submits that consideration of this record as a whole clearly establishes this aspect of the invention as giving life and meaning to the claims, and should be viewed as a limitation in the claims.

The Examiner further asserts “that Appellant has not cited a claim step which is not shown by the combination of Golden and Corlett.” Appellant respectfully and strongly disagrees. In Appellant’s Response to Office Action of December 20, 2002 (Paper No. 7), which is explicitly referred to in lines 15-19 on page 5 of the Brief, Appellant specifically identifies steps of each independent claim which are not shown by the combination of Golden and Corlett. Those limitations include at least the following:

CLAIM	STEPS NOT SHOWN
Claim 1	c, d, and f
Claim 7	f
Claim 11	c(1)
Claim 12	c
Claim 15	c and d
Claim 17	c
Claim 26	c
Claim 35	c and e

Appellant further argues in Paper No. 7 and the Brief that Golden cannot be modified by Corlett to remedy these deficiencies. As has been argued extensively in this record, Corlett discloses a method of personal financial planning in which a financial model is created from data relating to a subject's income, expenses, assets and liabilities. The specific element of Corlett relied upon by the Examiner is an "automatic allocation and funding program" illustrated in Figures 5a and 5b of Corlett. This program utilizes information collected from an individual and entered into a rules planning database to help make decisions about allocating surpluses or funding deficits in cash flow during a given year.⁴

⁴ The operation of Corlett is discussed in additional detail on pages 10 and 11 of Paper No. 7.

Appellant has submitted an Affidavit⁵ from one of skill in the art explaining that a program such as that described by Corlett would not and could not be used in the administration of variable annuities. The Examiner discounts the Affidavit as “a self-serving statement of opinion, not fact.” He then proceeds to opine that “[T]here is no reasoning provided as to why some features of Corlett cannot, and would not, be used.” More pertinent, however, is that there is no reasoning provided by the Examiner as to why Corlett could and would be used to modify Golden. This is particularly telling since it is beyond dispute that Golden and Corlett relate to entirely different types of financial products. The only motivation that Appellant can discern for modifying Golden in view of the teachings of Corlett is an attempt by the Examiner to reconstruct in hindsight the combinations of limitations set forth in the claims on appeal. Such motivation is, of course, improper.

Finally, in the closing paragraph of the Answer, the Examiner states, with apparent reference to step f of independent claim 4, that the alternatives set forth in f(1) and (2) are trivial, and that it “is not a ground breaking phenomena and would be obvious to one of ordinary skill in the art” that one could not withdraw money from an account if no money is left in the account. This final paragraph demonstrates that the Examiner does not understand the invention as defined by this limitation. Pursuant to step f of claim 4, payments will be made as long as the account value balance is greater than zero or the withdrawal rate is less than the predetermined maximum withdrawal rate introduced in step e. This means that, as long as the rate of withdrawal is less than the predetermined maximum withdrawal rate, an annuitant can continue to withdraw money from the account, even after the account balance reaches zero. As is illustrated by the Examiner’s own expression of disbelief, such a result would not be obvious to one of ordinary skill in the art.

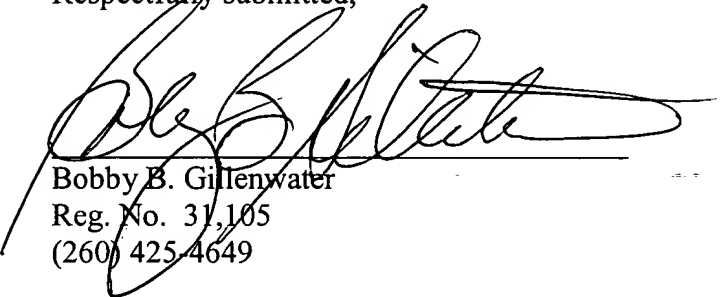
⁵ See Response filed on July 28, 2003.

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Conclusion

For the reasons set forth above and in Appellant's Appeal Brief, the Examiner's rejections of Claims 1-43 should be reversed.

Respectfully submitted,



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Filing Date: September 24, 1999
Group Art Unit: 3627
Examiner Name: Michael A. Cuff
Attorney Docket No.: 37168/82045
First Named Inventor: Jeffrey K. Dellinger
Title: METHOD AND APPARATUS
FOR PROVIDING
RETIREMENT INCOME
BENEFITS

Certificate Under 37 CFR 1.8(a)

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on May 18, 2004

Stacey E. Tolar

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Remarks:


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Date: May 18, 2004